

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Peter Schwalbach
Appl. No.: 10/511,536
Conf. No.: 4420
Filed: October 15, 2004
Title: TELECOMMUNICATION MODULE HAVING A SYSTEM DATA
PROCESSOR FOR PERFORMING AT LEAST ONE
TELECOMMUNICATION ACTIVITY
Art Unit: 2617
Examiner: Kiet M. Doan
Docket No.: 112740-1019

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the final Office Action dated January 12, 2007. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 15-29 are pending in the application. Independent claims 15 and 21 are the focus of this request. Favorable reconsideration is respectfully requested by the Panel.

Independent claims 15 and 21 have been repeatedly rejected under 35 U.S.C. §103(a) as being obvious in view of the cited references. In particular, the Examiner alleges that all the limitation recited in the above claims is taught or suggested by Miller et al. (U.S. Patent No. 6,535,911, hereafter “Miller”) in view of Krischnan et al. (U.S. Patent No. 6,075,863, hereafter “Krischnan”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine their teachings. In re Fine, 837 F.2d 1071, 5, U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co. Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986) Finally, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q., 580 (CCPA 1974).

The Applicants maintain that the Examiner has not satisfied all the basic criteria noted above; namely the first and final criteria. Miller is directed to updating information sets and Krishnan is directed to modems. Thus, one of ordinary skill in the art would not be motivated to combine or modify their teachings to arrive at the present invention. Additionally, even if combined, the cited references fail to teach or suggest all the features recited in at least independent claims 15 and 21.

In particular, Miller and Krishnan, individually or in combination, fail to teach or suggest the following claimed features: “a system data processor for performing at least one telecommunication activity, the at least one telecommunication activity being exclusively limited to at least one of creating, setting up, implementing, monitoring and terminating a telecommunication connection with the wireless mobile communication network”; “a control data processor that is logically separated from the system data processor, the control data processor automatically executing at least one control instruction sequence stored in the telecommunication module, the at least one control instruction sequence being implemented such

that, upon execution, the at least one telecommunication activity is initiated”; and “a connector for further connecting the control data processor to an external electronic device.”

Regarding Miller, the reference teaches a system and method for maintaining an updated version of information originated from a distribution media (see Miller, Abstract). In pertinent part, Miller teaches a general purpose computer 155, a communication network 150, a network interface 149 and a storage device 170. As described in Miller, the network interface 149 corresponds to the “telecommunication module,” not the viewing computer 155. And the network interface 149 does not include a system data processor. In fact, the only processor mentioned in Miller is the processor 160, which is part of the viewing computer. Additionally, as correctly noted by the Examiner, Miller is silent with regard to the recited “control data processor that is logically separated from the system data processor” and the “connector for further connecting the control data processor to an external electronic device” (see Office Action, pages 2-3). Accordingly, independent claims 15 and 21 are clearly distinguished over Miller.

Although the Examiner relies on Krishnan for overcoming the deficiencies noted above in Miller and for rejecting the above claims, the reference still appears to fall short of the present invention. Krishnan is directed to a communication device that is controlled through the use of small programs or applets, which are executed by a processor within the device. In particular, a modem 10 is controlled using the programs or applets that are executed by the processor 18 in the modem 10. The programs or applets can be loaded into the modem 10 from a host computer 12 that is connected to the modem 10 via an external port 16. The modem 10 is also provided with a jack 26 for coupling to a telephone line 14 (see Krishnan, Fig. 1).

In the Office Action, the Examiner interprets the host computer 12 as the claimed “system data processor,” and the processor 18 as the claimed “control data processor.” However, in the present invention, the system data processor in the telecommunication module is used for performing at least one telecommunication activity with a wireless mobile communication network. Conversely, in Krishnan, there is only one processor 18 in the modem 10, and that processor 18 is used for connecting to a telephone line 14. Thus, Krishnan fails to teach or suggest “a direct connection to a wireless mobile communication network,” as claimed.

Moreover, in the present invention, the telecommunication module includes a control data processor that is logically separated from the system data processor. In Krishnan, the

modem 10 only includes one processor 18. Although the Examiner attempts to interpret the host computer 12 as equivalent to the claimed system data processor, this interpretation appears erroneous. As claimed, the telecommunication module include two processors (i.e., a system data processor and a control data processor). On the other hand, in Krishnan, the host computer 12 is clearly not part of the modem 10. Moreover, even if the host computer 12 were part of the modem 10, Krishnan provides no hint that the host computer 12 performs “at least one telecommunication activity being exclusively limited to at least one of creating, setting up, implementing, monitoring and terminating a telecommunication connection with the wireless mobile communication network,” as claimed. Thus, Krishnan fails to teach or suggest all the features of the claimed system data processor and control data processor.

Finally, in the Office Action, the Examiner interprets the host computer 12 also as the external device. However, as noted previously, the Examiner already interpreted the host computer 12 as equivalent to the system data processor, which (as claimed) is a subcomponent of the telecommunication module (i.e., modem 10). Thus, given the Examiner’s previous interpretation of the host computer 12 (i.e., a subcomponent of the modem 10), the host computer 12 can not be “an external electronic device.”

In summary, Miller is directed to updating information sets and Krishnan is directed to modems. Thus, there is no motivation to combine or modify their teachings to arrive at the present invention. Additionally, even if combined, neither Miller nor Krishnan teach or suggest a telecommunication module that includes a system data processor and a control data processor, let alone a system data processor and a control data processor performing all the features recited in at least independent claims 15 and 21. Finally, no other cited references relied on by the Examiner overcome the deficiencies noted above in Miller and Krishnan.

In light of the above, Applicants respectfully submit that the rejections to claims 15-29 are improper and should be reversed by this Panel. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. 0112740-1019 on the account statement.

Respectfully submitted,

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